

REMARKS

These remarks are in response to the Office Action mailed April 9, 2003. Claims 17-18 and 33-34 have been canceled without prejudice to Applicant's right to prosecute the canceled subject matter in any divisional, continuation, continuation-in-part, or other application. Claims 1-2, 4, 6, 8-10 and 12 have been amended to further define Applicant's invention. New claims 35-42 have been added. Applicant respectfully requests consideration and allowance of the pending claims.

I. REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-16 and 19-32 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action alleges that the term "hydrocarbyl" is an insufficient search term as it encompasses ethyl and phenyl. Applicant respectfully traverses.

Applicant respectfully directs the Examiner to the element recited in Applicant's claims, "wherein the hydrocarbyl group has 11 to 29 carbon atoms." As the Examiner knows phenyl has 6 carbon atoms and naphthyl has 10 carbon atoms. Thus, the hydrocarbyl group is limited by the number of carbon atoms. Applicant submits that such a group is searchable.

The Office Action alleges that claim 2 is unsearchable. Applicant has amended claim 2. Applicant submits that claim 2 is searchable.

The Office Action alleges that claim 4 is illogical as it relates to claim 3 in that it is unclear where the R2 is in the oxazolidinone ring and the morpholine ring. Applicant has amended claims 3 and 4, and added new claims 35 and 36. Applicant believes that this clarifies claim 3 and the claims dependent therefrom.

Claim 8 is allegedly not searchable. No reasons are given. Applicant has amended claim 8. Applicant submits that the claim is searchable.

Claims 6 and 9 are allegedly unsearchable. Applicant has amended claims 6 and 9. Applicant submits that claims 6 and 9 are searchable.

Claims 10 and 12 are allegedly unsearchable. Claim 10 has been amended. Applicant submits that claim 10 is searchable.

II. REJECTION UNDER 35 U.S.C. §103

Claims 1-16 and 19-32 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stengel et al. European Journal of Pharmacology. Applicant respectfully traverses this rejection.

The examiner has argued that Stengel et al. tested efficacy of anandamide in reversing ionophore A23187 induced airway restriction in guinea pigs when administered by intravenous (IV) route even at high doses. Stengel et al. do not teach or suggest local administration of active therapeutic agents, but rather teach and suggest only IV administration. Applicant's claims recite "local administration to the upper respiratory airways". Thus, Stengel et al. do not teach or suggest Applicant's claimed invention.

Furthermore, Stengel et al. teach and suggest that IV anandamide is not an effective bronchodilator and has "minimal direct airway smooth muscle-related actions". (See the Abstract). Stengel believes that anandamide does not act directly to relax the airway smooth muscle in guinea pigs. Thus Stengel et al. teaches away from Applicant's claimed invention. Applicant submits that the delivery of cannabinoid receptor agonists is efficacious by local application of the compounds of the invention in aerosol formulations applied directly to the bronchial airway, as claimed by Applicant. This is not taught or suggested by Stengel et al.

Based on, at least, the foregoing reasons, Applicant respectfully requests withdrawal of the §103 rejection over Stengel et al.

The Office Action further alleges that claims 1-16 and 19-32 are unpatentable under 35 U.S.C. §103 over British Medical Association, Therapeutic Uses of Cannabis, 1997(V). Applicant respectfully traverses this rejection.

Applicant submits that Δ^9 -THC is as good a bronchodilator as therapeutically used antiasthmatic β -agonists. However, Applicant's claimed invention does not read on Δ^9 -THC, which is a cyclic structure, and are not structurally equivalent to the major cannabis active ingredient. Accordingly, this rejection may be properly withdrawn.

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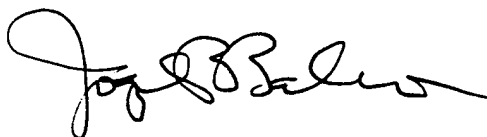
Attorney's Docket No.: 07306-019001 / 2000-202-1

Enclosed is a \$36.00 check for excess claim fees and a \$205.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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